

### **REMARKS**

The present amendment and remarks are responsive to the Non-final Office Action mailed on September 13, 2006. By the foregoing amendments, Claims 1-28 have been cancelled and new Claims 29-52 have been added. Applicants respectfully submit that no new matter has been added by the foregoing amendments. In view of the amendments and remarks, Applicants respectfully assert that the objections and rejections are now made moot and that the pending claims are in condition for allowance.

#### **Claim Rejection – 35 USC §103**

In the Office Action, Claims 1-5, 8-11, 13-17, 20-23, 26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kitchen in view of U.S. Patent No. 6,128,603 to Dent et al. In the Office Action, the teaching of Kitchen is combined with the teaching of Dent, which allegedly discloses a payer disputing a bill and submitting a payment for a revised amount of the available bill. It is contended that, although neither Dent or Hogan teach the biller determining the revised amount of the available bill, the determination of the revised amount of the available bill is well known in the art. It is concluded in the Office Action that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the method of Kitchen with the teaching of Dent to allow a payer to dispute a bill and the biller to determine the revised amount of the available bill.

Dent is directed to a consumer-based bill management and payment system that allows a biller to distribute billing statements via a service center (see column 4, lines 40-44). Dent also enables a consumer to dispute an item in an electronic billing statement 110, which is also referred to in Dent as the bill UI 110. As generally described in the text cited by the Examiner in the Office Action, that is, column 10, line 42, column 11, line 42, Dent teaches that a consumer can dispute an item listed in the bill UI 110 by clicking on an appropriate column cell identifying a prearranged dispute reason for non-payment or partial payment of the disputed item. While the bill UI 110 is designed to automatically adjust the amount paid column 116 so the amount paid by the customer reflects the disputed amount, the amount due column 114 is static and does not

change (see column 11, lines 1-3). Thus, as noted by the Examiner, the biller in Dent does not determine a revised bill amount (i.e., the amount due column). Instead, it is the customer in Dent that determines a revised paid amount (i.e., the amount paid column) without biller approval or review of the disputed amount.

The Examiner contends that the biller determining a revised bill amount is well known in the prior art; however, the Examiner has failed to point to any example within the prior art of the biller determining a revised bill amount. Applicants, therefore, demand under MPEP 2144.03 that the Examiner produce authority for his statement. The MPEP states that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (MPEP 2144.03). Here, the biller determining a revised bill amount in an electronic bill payment network is beyond instant and unquestionable demonstration as being well-known. For at least this reason, the claims of the present application are allowable over the prior art of record cited by the Examiner.

Although the Applicants believe that Claims 1-5, 8-11, 13-17, 20-23, 26 and 28 are in condition for allowance, in order to expedite the prosecution of the present application, new Claims 29-52 have been provided in place of Claims 1-5, 8-11, 13-17, 20-23, 26 and 28. In marked contrast to the teaching of Dent, new independent Claim 29 recites that a biller station “receives a disputation of the first amount of the available bill” and “transmits, in response to the received disputation, a revised amount of the available bill and a selectable payment indicator, wherein selection of the selectable payment indicator by the user is configured to establish a communication link between the user and a payment entity in order to transmit a request from the user to the payment entity to pay the revised amount of the available bill to the biller on behalf of the user.” The other new independent claims, that is, Claims 37, 48, 51, and 52 recite substantially similar limitations. Accordingly, the determination and transmission of the revised amount by the biller occurs after the consumer has disputed the initial bill with the biller. The biller considers the dispute and then sends the consumer a revised amount and a selectable payment indicator. By selecting the selectable payment indicator, a user is connected to a

payment entity in order to transmit a request to pay the revised amount to the biller on behalf of the user.

Dent, on the other hand, teaches a system for simultaneously submitting a dispute to the biller with a payment that includes a reduction for the disputed items, notwithstanding that the biller has not approved or agreed with that the dispute(s) is valid. Thus, Dent fails to teach or suggest the biller determining the revised amount and then transmitting the revised amount and a selectable payment indicator to the user in response to the disputation, as expressly recited in each of independent Claims 29, 37, 48, 51, and 52. In fact, Dent teaches away from the claimed invention by teaching that the amount due column 116 (i.e., the amount of the bill determined by the biller) is static and is not changed or revised when a dispute is indicated via the bill UI 110 (See, e.g., column 11, lines 1-3). Thus, there is no teaching or suggestion of a revised amount from the biller. While the amount paid column 116 (i.e., the amount the consumer is going to pay after deductions for the disputed items) changes at the indication of a dispute, that change occurs as an automatic feature of the bill UI 110, and is not determined by the biller. Further, the pay instructions in Dent are not for a revised amount determined by the biller, but for an amount determined by consumer via the bill UI 110.

In addition, neither Kitchen nor Dent appear to teach or suggest the biller transmitting a selectable payment indicator to the consumer, wherein selection of the selectable payment indicator by the consumer will establish a communications link between the consumer and a payment entity, in order to transmit a request to pay the revised amount of the available bill to the biller on behalf of the user, as recited in independent Claim 29. Independent Claims 37, 48, 51, and 52 recite similar limitations. In marked contrast, Dent merely discloses that the consumer may return a payment instruction to the biller or a representative of the biller (see column 5, lines 4-6). Accordingly, in Dent, a payment instruction must be returned or transmitted back to the entity that electronically distributed the bill to the consumer. There is no suggestion of establishing a communications link between the consumer and a third party payment entity in order to transmit a request to pay the revised amount of the available bill to the biller on behalf of the user. Likewise, there is no teaching or suggestion in Kitchen of the biller transmitting a selectable payment indicator to the consumer, wherein selection of the selectable

payment indicator by the consumer will establish a communications link between the consumer and a payment entity, in order to transmit a request to pay the revised amount.

Accordingly, new independent Claims 29, 37, 48, 51, and 52 are patentable over Kitchen and Dent taken alone or in combination. Likewise, the remaining claims that are dependent on Claims 29, 37, 46, and 49 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

### **CONCLUSION**

The Applicants believe they have responded to each matter raised by the Examiner. Allowance of the claims is respectfully solicited. Any questions may be directed to the undersigned at 404.853.8233. It is not believed that fees for addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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